

## REMARKS

### **INTRODUCTION**

In the Office action mailed September 27, 2004, claims 1-15 were rejected. In accordance with the foregoing remarks, reconsideration of pending claims 1-15 is respectfully requested.

### **CLAIMS 1-4 REJECTED UNDER 35 U.S.C. §101**

On page 2, numbered paragraphs 1-2 of the Office action, the Examiner rejected claims 1-4 under 35 U.S.C. §101 because the claimed invention is purportedly directed to non-statutory subject matter. The Examiner purports that in claims 1-4, a method for preparing a program can be accomplished through mental steps.

In accordance with the foregoing rejection, Applicant has amended independent claim 1 to additionally recite: "A method for preparing a program for die machining to be performed by a computer, ... " Therefore, since the method of claims 1-4 is performed by a computer, the claims should no longer be interpreted as being directed to non-statutory subject matter. Therefore, Applicant respectfully requests that the rejection of claims 1-4 is overcome and that claims 1-4 patentably distinguish over the references relied upon by the Examiner.

### **REJECTION OF CLAIMS 9-14 UNDER 35 U.S.C. §112(2)**

On page 2, numbered paragraph 3 of the Office action, the Examiner rejected claims 9-14 under 35 U.S.C. 112(2) as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner asserted that the scope of "programs capable of creating another program for machining" is unclear.

Applicant believes that the Examiner mistakenly understands the scope of claims 9-12. Claims 9-12 clearly point out and distinctly claim "a computer readable storage medium storing a program for allowing a computer to prepare a program." Thus, a computer readable storage medium stores a program that enables a computer to prepare another program. Support for the aforementioned subject matter is found on page 14, lines 18-29 of the originally filed specification for the present application, which recites the following:

The above-mentioned program preparation apparatus is different from the conventional program preparation apparatus in that a system program is stored therein for automatically preparing a program for die machining based on an input machining shape, an input machining-start point, an input approach point and an input number of machining processes.

Fig. 6 is a flow chart of a procedure for the program preparation apparatus 30 to prepare a program for die machining in accordance with a program for preparing a program for die machining contained in the system program of the program preparation apparatus.

Further, Examiner mistakenly suggests deleting the words "for preparing a program" in claims 11-14. These words are not included in any of claims 11-14 and the claims do not depend from claim 9, which includes the words. Therefore, applicant respectfully asserts that Examiner's rejection of claims 11-14 is mistaken and not based on the claim language present in the claims.

In accordance with the foregoing, Applicant respectfully requests that the rejection of claims 9-14 is overcome and the claims patentably distinguish over the references relied upon by the Examiner.

**REJECTION OF CLAIMS 5-15 UNDER 35 U.S.C. 102(B) OR 103(A) BY TAKEGAHARA ET AL. (U.S. PATENT NO. 6,356,799)**

On page 2, numbered paragraph 4 of the Office action, the Examiner rejected claims 5-15 under 35 U.S.C 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takegahara et al. in U.S. Patent No. 6,356,799 ("Takegahara"). To establish anticipation of a claimed invention, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). For at least the reasons discussed below, Takegahara does not teach or suggest all of the elements of claims 5-15; therefore, the foregoing rejections are respectfully traversed.

The reference relied upon by the Examiner, Takegahara, relates a storage medium for a coreless wire cutting electronic discharge machine, the medium stores a core-less machining shape determining program that is executed or selected from stored programs based on data of a machining shape and reference values for judgment. Takegahara, column 3, lines 45-61. The coreless wireless cutting electronic discharge machine described in Takegahara, which includes an NC automatic programming device capable of preparing a program for a coreless machining path, does not include a feature in which the NC automatic programming device prepares the program so that approach points which are machine-start points on the machining path are different from each other in different machining processes.

Claim 5 of the present application, in part, recites: "... wherein said program preparing means prepares the program so that approach points, which are machining-start points on the machining path, are different from each other in different machining processes."

In a non-limiting example, the above feature of claim 5 is important because such feature makes it possible to avoid the formation of a dent at the approach point because the approach points are different from each other in different machining processes. See Specification, page 10, line 30 through page 11, line 7.

Takegahara does not teach or suggest a "program preparing means prepares the program so that approach points, which are machining-start points on the machining path, are different from each other in different machining processes," as is recited in claim 5 of the present application. Instead, Takegahara simply discloses a coreless wire cutting electric discharge machine which includes an NC automatic programming device capable of preparing a program for a coreless machining path. Takegahara does not teach or suggest having the NC automatic programming device prepare the program so that approach points which are machining-start points on the machining path are different from each other in different machining processes.

No such showing has been made in the present Office Action that Takegahara teaches or suggests a "program preparing means prepares the program so that approach points, which are machining-start points on the machining path, are different from each other in different machining processes," as is recited in claim 5 of the present application. Instead, the Examiner simply states that the NC automatic programming device is "capable of preparing a program for any coreless machine path." It is submitted that the reason why no such showing was made of the above-recited feature is because Takegahara fails to teach, suggest, or otherwise provide the feature.

Each of independent claims 9 and 11 similarly recite the above-described feature of claim 5. Therefore, for at least the reasons that claim 5 patentably distinguishes over the reference relied upon by the Examiner, Applicant respectfully requests that claims 9 and 11 also patentably distinguish over the reference relied upon by the Examiner.

For example, claim 9 recites: "... said computer prepares a program for die machining so that approach points, which are machining-start points on the machining path, are different from each other in different machine processes."

Claim 11 recites, "... repeating a plurality of machining processes along a predetermined closed machining path so that approach points, which are machining-start points on the closed machining path, are different from each other in different machining processes ..."

Claims 6-8, 10, and 12-15, depend from independent claims 5, 9, and 11. Therefore, for at least the reasons that independent claims 5, 9, and 11 patentably distinguish over the reference relied upon by the Examiner, it is respectfully requested that dependent claims 6-8, 10, and 12-15 also patentably distinguish over the reference relied upon by the Examiner.

**CONCLUSION**

In accordance with the foregoing, claims 1, 3-4, 9-11, and 14 are amended. claims 1-15 are pending and under consideration.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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